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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,436	11/08/2001	Yukifumi Uotani	CU-2710 RJS	7089

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/010,436

Applicant(s)

UOTANI, YUKIFUMI

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 11-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to a forming mold, classified in class 425, subclass 111.

II. Claims 17-24, drawn to a method of manufacturing a forming mold, classified in class 264, subclass 2.5.

2. Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process wherein the four sides of a blank body are not cut, but rather wherein the sides of the blank body are used as they are originally formed.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Brian Hameder (Applicant's Representative) on March 27, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-24 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-2 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pub. No. 03-128212 (hereinafter "JP '212").

JP '212 discloses a forming mold for a lens sheet. The mold comprises a mold body (1) and a receiving member (7) for receiving a superfluous amount of resin. The receiving member is provided on one side of the periphery of the mold body (see figures 6 and 10). The mold further comprises a supporting plate (4) to which the mold is secured (see figure 10). JP '212 also discloses the mold to be as such to have a downward incline upper surface in a direction from the mold body to the receiving member (see figure 10).

The recitation of the intended use of the apparatus in the preamble, specifically the use of the apparatus in a process of forming a lens sheet, has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (Cust. & Pat. App. 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (Cust. & Pat. App. 1951). Note further that it is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use,

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then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963).

8. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryer et al. (U.S. Pat. No. 2,733,494).

Bryer discloses a molding apparatus. The apparatus comprises, in the embodiment shown in figure 4, a mold body (37) and a receiving member (39) for receiving a superfluous amount of the molding material (see figure 4). The receiving member is provided on the pressing-finishing side of a periphery of the mold body.

Bryer further discloses the mold body to comprise a molding plate (3) and a supporting plate (5) on which the molding plate is secured. A gap between the mold body and the receiving member is filled with a filler (47). The receiving member has a portion having a downward incline upper surface in a direction from the mold body to the receiving member (see figure 4).

Thus, Bryer teaches a molding apparatus which anticipates the structural limitations of the claims. As noted above, the intended use of the apparatus recited in the claims is of no patentable weight.

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9. Claims 11-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not teach or suggest a forming mold comprising a mold body and a receiving member for receiving a superfluous amount of molding material, the receiving member being provided on at least the pressing-finishing side of a periphery of the mold body, wherein either (a) a gap between the mold body and the receiving member is filled with a filler and the mold body has a portion which comes into contact with the receiving member, with the portion having a downward inclined upper surface in a direction from the mold body to the receiving member as recited in claims 11 and 12; or (b) wherein the receiving member has a portion which comes into contact with the mold body, the portion having a downward inclined upper surface in a direction from the mold body to the receiving member and the mold body has a portion which comes into contact with the receiving member, with the portion having a downward inclined

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upper surface in a direction from the mold body to the receiving member as recited in claims 13-16.

The closest prior art disclosed by JP '212 and Bryer is discussed above. Neither of the references discloses the combination of features recited in the indicated allowable claims. Nor is there any motivation to combine the features of these two references to suggest the combination of features recited in the indicated allowable claims.

11. The following references are cited, but not relied upon, as being pertinent to the instant application:

Japanese Pub. No. 03-75702 discloses a forming mold for forming a lens sheet which comprises an receiving member (3) for receiving superfluous molding resin (see figures 1-5).

Japanese Pub. No. 03-114002 discloses a forming mold for forming a lens sheet which comprises receiving members (7) for receiving superfluous molding resin (see figure 5).

Japanese Pub. No. 06-118206 discloses a lens sheet forming mold which comprises a receiving member (13) for receiving excess




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resin (see also the machine translation attached to this document).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.



Donald Heckenberg  
May 30, 2003



JAMES P. MACKEY  
PRIMARY EXAMINER

6/2/03